

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 29973
	:	
Thomas DISTEFANO III	:	Confirmation Number: 8542
	:	
Application No.: 09/589,551	:	Group Art Unit: 3688
	:	
Filed: June 7, 2000	:	Examiner: D. Lastra
	:	
Appeal No. 2009-000339	:	
	:	
For: METHOD FOR DEVELOPING ELECTRONIC DOCUMENTS PROVIDING E-COMMERCE TOOLS		

**REQUEST FOR REHEARING**

Mail Stop Appeal Brief - Patents  
Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.52 in response to the Decision on Appeal dated June 15, 2009 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Application No.: 09/589,551

Appellant respectfully submits that in the Decision on Appeal, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellant in the Appeal Brief of November 19, 2007, and in the Reply Brief of June 4, 2008. Appellant will specifically identify these particular points below.

**REMARKS**

Decisions of the PTO tribunals are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. § 706, to appeals of PTO rulings). Thus the Board's factual findings are reviewed to determine whether they are unsupported by substantial evidence, and the Board's legal conclusions are reviewed for correctness in law. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000).

**Claim 1**

Independent claim 1 recites the following limitations:

during design of the first website, receiving  
information at a user interface indicating a type of an element for  
marketing that is to be displayed at the second website, and  
information specifying the second website at which the element is  
to be displayed.

On page 2 of the Decision, the Honorable Board identified these limitations as "limitation [1]." Regarding limitation [1], the Examiner asserted the following on page 12, lines 16-22:

This information is received at the user interface prior to final approval (FF 10) and is therefore during the design of the website, or at least that particular advertising piece of the second website. The design of any aspect of a web site is a component of the design of the web site itself and thus fits the limitation of

1 occurring during design of the web site. We therefore find the Examiner's position  
2 that Mason describes limitation [1] supported by substantial evidence.  
3

4 Appellant respectfully submits that the Honorable Board's analysis has erred  
5 in at least two respects. First, the Examiner did not allege that Mason describes all  
6 of limitation [1]. Referring to the fourth full paragraph on page 3 of the Fourth  
7 Office Action and to the third to last full paragraph on page 3 of the Examiner's  
8 Answer, the Examiner only asserted that Mason teaches the language "receiving  
9 .... to be displayed" from limitation [1]. Absent from the Examiner's statements,  
10 however, is an assertion that Mason teaches the "during design of the first website"  
11 aspect of limitation [1].  
12

13 Instead, referring to page 3 of the Fourth Office Action and page 5 of the  
14 Examiner's Answer, the Examiner specifically asserted:

15 Mason does not expressly teach *during the design of the first website* causing the  
16 display of the element for marketing at the second website when the first website  
17 is activated with respect to the internet. (italics added)  
18

19 The phrase "during the design of the first website" only occurs once in claim 1, and  
20 thus, the Examiner's assertion of what Mason does not teach refers to the recitation  
21 of this phrase within limitation [1]. Therefore, how the Honorable Board  
22 characterized the Examiner's position and the Examiner's explicitly stated position  
23 in the Fourth Office Action and in the Examiner's Answer are not the same.

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3        Additionally, with regard to the claimed "during the design of the first  
4 website," Appellant presented extensive arguments in the paragraph spanning on  
5 pages 6 and 7 of the Appeal Brief that the Examiner has mischaracterized the  
6 differences between the claimed invention and the prior art (i.e., one of the Graham  
7 factual inquiries) by associating the "during the design of the first website" with  
8 the "causing the display of the element for marketing at the second website when  
9 the first website is activated with respect to the internet." The claimed "during the  
10 design of the first website" modifies the step of "receiving information ..." and not  
11 the step of "causing the display," as alleged by the Examiner. As a matter of logic,  
12 if the first website is activated, the design of the first website has already been  
13 completed. Thus, the step of "causing the display ..." does not occur "during the  
14 design of the first website. The Honorable Board's Decision, however, does not  
15 address this critical mischaracterization by the Examiner.

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18        As reproduced above, on page 12, lines 19-20 of the Decision, the  
19 Honorable Board presented the following analysis "[t]he design of any aspect of a  
20 web site is a component of the design of the web site itself." Appellant has not

1 found this claim construction in the Examiner's analysis. As such, Appellant  
2 presumes that this claim construction has been newly presented.

3  
4 During patent examination, the pending claims must be "given their broadest  
5 reasonable interpretation consistent with the specification." In re Hyatt, 211 F.3d  
6 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). The *broadest* reasonable  
7 interpretation of the claims must also be consistent with the interpretation that one  
8 skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d  
9 1464, 1468 (Fed. Cir. 1999). Appellant respectfully submits that the Honorable  
10 Board's claim construction is not reasonable and eviscerates any definite meaning  
11 from the phrase "during the design of the first website."

12  
13 The phrase "during" refers to a duration, which is the time during which  
14 something exists or lasts. Thus, the phrase "during the design" refers to the time  
15 during which the design of the first website lasts. For sake of argument, consider  
16 what would occur if a website was being design for Bass Brewery. This website  
17 includes Bass Brewery's trademark (i.e., including a red triangle) and the font used  
18 in the website is Times New Roman. The Bass Brewery trademark has the  
19 distinction of having one of the oldest trademarks (registered in 1875) and the  
20 Times New Roman font was designed in 1931. The symbol of a triangle (i.e., "Δ")

1 dates back to at least 300 BC, in which Euclid discussed elementary facts about  
2 triangles in books 1-4 of Elements.

3  
4 If "[t]he design of any aspect of a web site is a component of the design of  
5 the web site itself," then the duration that this hypothetical website was being  
6 "designed" extends back nearly 24 centuries since a triangle falls under the  
7 definition of "any aspect of a web site" as does a trademark displayed in the  
8 website or a font used in the website. Appellant respectfully submit it is  
9 unreasonable to construe the phrase "during the design of the first website" to  
10 include durations that predate the birth of the website designer or the advent of the  
11 internet.

12  
13 Appellant respectfully submit that the phrase "during the design of the first  
14 website" refers to the duration that starts when a designer makes an definitive step  
15 to design the website and ends when the design of the website has been completed.  
16 Otherwise, to construe that phrase in manner suggested by the Honorable Board,  
17 this phrase would encompass periods when the design of the first website is  
18 technically impossible (i.e., since the internet had not yet been invented) or the  
19 design of the first website was not even contemplated by the designer.

1           Based upon Appellant's proposed definition, Appellant respectfully submit  
2   that the Honorable Board would reach the conclusion of both Appellant and the  
3   Examiner that Mason fails to teach the claimed "during the design," which is both  
4   contrary to and critical to the Honorable Board's analysis.

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6           Claim 8

7           In the paragraph spanning pages 15 and 16 of the Decision, the Honorable  
8   Board presented the following analysis:

9                       We disagree with the Appellant. A banner ad is simply a link in an HTML  
10                      document. The contents of the ad are non-functional descriptive material and are  
11                      accorded no patentable weight. *In re Ngai*, 367 F.3d at 1339. More shows such  
12                      links (FF 04).  
13

14   Upon reviewing the Examiner's appealed rejection in the Fourth Office Action  
15   dated June 18, 2009, and the Examiner's analysis in the Examiner's analysis,  
16   Appellant has been unable to identify any reliance upon In re Ngai by the  
17   Examiner. Since the Examiner failed to rely upon In re Ngai and the Honorable  
18   Board relies upon this case law to support the Honorable Board's analysis, this  
19   reliance upon In re Ngai represents a new ground of rejection. As such,  
20   designation as a new ground is necessary because Appellant has not had a fair  
21   opportunity to react to the thrust of the "affirmance" of the rejection, which is  
22   based upon case law that was not cited to Appellant until after the Decision had



1 been rendered by the Honorable Board. See In re Kumar, 418 F.3d 1361, 1367-68  
2 (Fed. Cir. 2005) ("the ultimate criterion of whether a rejection is considered 'new'  
3 in a decision by the board is whether appellants have had fair opportunity to react  
4 to the thrust of the rejection") (quoting In re Kronig, 539 F.2d 1300, 1302 (CCPA  
5 1976)).

6  
7 The Honorable Board's reliance upon In re Ngai is misplaced. Both In re  
8 Ngai and the related case of In re Gulack, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir.  
9 1983), involved issues regarding printed matter. However, the claimed invention  
10 does not involve printed matter. Instead, the claimed "banner ad" is a type of data  
11 structure that includes more than just "simply a link in an HTML document," as  
12 alleged by the Honorable Board. Banner ads also include a graphical image file  
13 and a means to connect the link to a graphical image file. The banner ad can also  
14 be animated, which requires a mechanism to do so or even be interactive with a  
15 user input (e.g., a mouse). Thus, one skilled in the art would recognize the claimed  
16 "banner ad" is a particular type of data structure that includes more than just a link.

17  
18 Reference is made to the following discussion within In re Lowry, 32 F. 3d  
19 1579, 1583, 32 USPQ 2nd 1031, 1034 (Fed. Cir. 1994), as to the differences  
20 between a data structure and printed matter:

1       The printed matter cases “dealt with claims defining as the invention  
2       certain novel arrangements of printed lines or characters, useful and  
3       intelligible only to the human mind.” *In re Bernhart*, 417 F.2d 1395,  
4       1399, 163 USPQ 611, 615 (CCPA 1969). The printed matter cases  
5       have no factual relevance where “the invention as defined by the  
6       claims *requires* that the information be processed not by the mind but  
7       by a machine, the computer.” *Id.* (emphasis in original). Lowry’s data  
8       structures, which according to Lowry greatly facilitate data  
9       management by data processing systems, are processed by a machine.  
10      Indeed, they are not accessible other than through sophisticated  
11      software systems. The printed matter cases have no factual relevance  
12      here.

13  
14      As claimed, (i) a search request for banner ad designs is received at the user  
15      interface; (ii) the results of the search are displayed on the user interface; (iii) and  
16      the first banner ad design is selected via the user interface. Thus, the banner ad  
17      design is information that is processed using a machine (e.g. a computer). Thus,  
18      Appellant respectfully submit that the Honorable Board's reliance upon In re Ngai  
19      is misplaced. Moreover, as a result of the Honorable Board's improper reliance  
20      upon In re Ngai, the Honorable Board has not given patentable weight to full  
21      meaning of the term "banner ad" and "banner ad design." As argued on page 11 of  
22      the Appeal Brief and on page 9 of the Reply Brief, not only has the Examiner  
23      failed to establish that the applied prior art teaches the claimed banner ad or banner

1 ad design, the Examiner has failed to establish that applied prior art teaches any of  
2 the other limitations associated with claim 8.

3

4 For the reasons set forth in the Appeal Brief and in the Reply Brief,  
5 Appellant respectfully solicits the Honorable Board to reverse the Examiner's  
6 rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 503839, and please credit any excess fees to such deposit account.

Date: August 17, 2009

Respectfully submitted,

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CUSTOMER NUMBER 29973